REMARKS

In the Office Action, the Examiner has objected to claims 14 and 16 because of informalities. Applicants submit that claims 2 and 16 as amended correct these informalities.

In the Office Action, the Examiner has rejected claims 1-3, 5-16, and 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8, 11, 12, 15, 16, 18, 19, and 20 of United States Patent 6,384,125 (hereinafter "Bergstrom et al.") in view of United States Patent 4,436,847 (hereinafter "Wagner). Applicants traverse this rejection.

Applicants submit that claim 1 of Bergstrom et al. is directed to a process which includes contacting silica with a combination of a non-sulfur containing functionalizing coupling agent (a) and an organometallic hydrophobing compound (b) to produce a modified silica filler. Claims 6, 8, 11, 12, 15 and 16 are dependent upon claim 1. Claims 18, 19, and 20 are directed to a modified silica filler made by the process of claim 1. Furthermore, claim 8 recites that the organometallic hydrophobing compound(s) can be selected from a group which includes (triethoxysilylpropyl)disulfide.

Applicants submit that Wagner claims the combination of an alkoxy silane with a silane coupling agent selected from a group of useful compounds. The group includes organic silane compounds containing an internal active olefinic linkage, bis(alkoxysilylalkyl)polysulfides, haloalkylsilanes, and silane compounds containing a vinyl functional group in the organofunctional portion of the compound

Bergstrom et al. and Wagner taken either alone or in combination do not suggest the combination of a sulfur-containing mercaptoorganometallic compound with a non-sulfur containing organometallic compound as claimed in the present invention. There would be no motivation for one of ordinary skill in the art to modify the Bergstrom et al. invention by selecting the mercaptoorganometallic compound, to the exclusion of any other compound in the group of silane coupling agents claimed in Wagner.

It is now well established by the Federal Circuit that cited prior art must provide one of ordinary skill in the art with the motivation to use the disclosure of a reference in a manner that renders the claims obvious; namely, there must be some teaching suggestion or incentive in the prior art disclosure that supports the rejection. This requirement stands as the critical safeguard against hindsight analysis and rote application of the legal test for obviousness. See, in particular, *In re* Rouffet, 47 USPQ 2d 1453, 1458 (Fed. Cir. 1998). Further, see, *In re* Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988), wherein the Court found that "The consistent criterion for determination of

obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art ... Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure."

Thus, Bergstrom et al. and Wagner taken either alone or in combination do not fairly suggest the present invention. Applicants invention is patentably distinct over either reference alone or in combination. Reconsideration and withdrawal of the rejection is requested.

In the Office Action, the Examiner has rejected claims 1-3, 5-16 and 18 under 35 U.S.C. 103(a) as being unpatentable over United States Patent 6,051,672 (hereinafter "Burns et al.") in view of United States Patent 4,436,847 (hereinafter "Wagner"). Applicants traverse this rejection.

Applicants submit that Burns et al. teaches that an aqueous suspension of hydrophilic non-aggregated colloidal silica can be reacted with one or more of the organosilicon compounds described by formulas 1 and 2 (see column 3, lines 56-60). A list of useful organosilicon compounds for use in the invention is disclosed (see column 4, lines 28-40). One skilled in the art could select from the list any one organosilicon compound or any combination of more than one organosilicon compound. The reference provides no guidance or direction to select any particular organosilicon compound and combine it with any other organosilicon compound. For example, a skilled artisan could select a silane in combination with another silane, or a silane in combination with a siloxane, or a siloxane in combination with another siloxane. Burns et al. does not teach nor suggest a specific combination comprising a mercaptoorganometallic compound and a non-sulfur organometallic compound as claimed in the present invention.

Applicants submit that Wagner claims the combination of an alkoxy silane with a silane coupling agent selected from a group of useful compounds. The group includes organic silane compounds containing an internal active olefinic linkage, bis(alkoxysilylalkyl)polysulfides, haloalkylsilanes, and silane compounds containing a vinyl functional group in the organofunctional portion of the compound.

As previously stated, it is now well established by the Federal Circuit that cited prior art must provide one of ordinary skill in the art with the motivation to use the disclosure of a reference in a manner that renders the claims obvious; namely, there must be some teaching suggestion or incentive in the prior art disclosure that supports the rejection. This requirement stands as the critical safeguard against hindsight analysis and rote application

of the legal test for obviousness. See, in particular, *In re* Rouffet, 47 USPQ 2d 1453, 1458 (Fed. Cir. 1998). Further, see, *In re* Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988), wherein the Court found that "The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art ... Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure."

Thus, in view of Burns et al. and Wagner taken either alone or in combination, absent an impermissible hindsight reconstruction using Applicant's invention as a roadmap, there would be no motivation for a skilled artisan to select a mercaptoorganometallic compound and a non-sulfur organometallic compound, to the exclusion of any other single compound or combinations of disclosed compounds. Reconsideration and withdrawal of the rejection is requested.

Further, the Examiner has rejected claims 4 and 17 under 35 U.S.C. 103(a) as being unpatentable over Burns et al. in view of various other patents. Applicants submit that these claims are dependent upon a valid base claim, and therefore, are also valid.

Applicants submit that claims 1-18 are in condition for allowance, and respectfully request reconsideration of these claims.

Very truly yours,

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